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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/626,699

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William John Jones

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FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

TODD, GREGORY G

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/626,699	Applicant(s) JONES ET AL.	
	Examiner GREGORY G. TODD	Art Unit 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-53,56-63,66-70,73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-53,56-63,66-70,73 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/15/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to applicant's amendment and request for continued examination filed 28 October 2010 of application filed, with the above serial number, on 27 July 2000 in which claims 46, 56, and 66-69 have been amended and claims 73-74 have been added. Claims 46-53, 56-63, 66-70, and 73-74 are therefore pending in the application.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claims have been amended to include a 'core network'. There is no antecedent basis for the claim terminology, and thus there is no description as to the scope of said network.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46-53, 56-63, and 66-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been amended to include a “radio access network” in the limitations of the claims. However, the preamble of the independent claims describe a “wireless network”. It is not clear as to whether the radio access network and wireless network are the same, as the specification suggests (there is no clear 'radio access network' terminology other than the Utran, and the Utran appears to be the same as the wireless network), or if the networks are different.

Similarly, the claims have been amended to include a “core network” in the limitations of the claims. However, the preamble of the independent claims describe a “UMTS access network”. It is not clear as to whether the core network and UMTS access network are the same, as the specification suggests (there is no clear 'core network' terminology), or if the networks are different.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 66 and 74 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 66 is drawn to a “computer readable medium”. The specification is silent regarding the meaning of this term. Thus, applying the broadest reasonable interpretation in light of the specification and taking into account the meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art (MPEP 2111), the claim as a whole covers both transitory and non-transitory media.

A transitory medium does not fall into any of the four categories of invention (process, machine, manufacture, or composition of matter). Further, similar claims 67 and 69, also computer readable medium claims, explicitly have been amended to include the 'non-transitory' language.

Claim 74 is a device claim comprising, essentially, code only. The claimed element's method steps are non-structural limitations as it is not clear as to the category of invention. Therefore, the claimed subject matter as a whole fails to fall within the definition of a process, machine, manufacture, or composition of matter, patentable eligible category subject matter.

In order to expedite a comprehensive examination of the instant application, the claims rejected under 35 U.S.C. 101 (non-statutory) above, are further rejected as set forth below in anticipation of applicant amending these claims to place them within the admissible statutory categories of invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 46-53, 56-63, 66-67, 69, and 73-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (hereinafter "Fujiwara", 6,064,879) in view of

Lipsit (hereinafter "Lipsit", 5,956,636), and further in view of Rai (hereinafter "Rai", 6,675,208).

As per Claim 46, Fujiwara teaches a method for a registration server of a wireless network, for registering a user equipment (UE) accessing the Internet through a Universal Mobile Telecommunications System (UMTS) access network, the method comprising:

establishing an anonymous communication session between the UE and the registration server via a radio access network and a core network, in response to authentication by an authentication server of a temporary ID and a temporary password identifying the UE as unregistered (authenticating temporary telephone number and ID) (at least col. 1, lines 31-60; col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35; radio link 24: radio access network, network 29/31: core network);

transmitting to the UE, via the anonymous communication session with the UE, a reply message comprising a request for registration information (at least col. 7 line 54 - col. 8 line 16; permanent).

Fujiwara fails to explicitly teach receiving, from the UE, in response to the request for registration information, a permanent ID and a permanent password. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Therefore, it would have been

obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Lipsit's system into Fujiwara as Lipsit's alternative activation/registration process allows the end recipient to activate the device using the ESN and security code of their choice.

Fujiwara and Lipsit fail to explicitly teach wherein the anonymous communication session uses a tunneling communications protocol. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rai. Rai teaches, in an analogous art, using Layer 2 tunneling protocol to connect user equipments and the interworking function in the networks for a secure connection (at least Rai col. 7:60-8:20). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Rai's layer 2 tunneling protocol into Fujiwara and Lipsit's system as Rai teaches the use of such protocol being well known to allow support for ISP access and connecting to private networks, thus improving on Fujiwara and Lipsit's system to connect to such networks.

As per Claim 47, Fujiwara fails to explicitly teach the requested registration information further comprises indicia of a preferred service provider, and the step of receiving, from the UE, in response to the request for registration information, includes receiving the indicia of a preferred service provider from the user equipment. However, the use and advantages for using such a service is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit (at least col. 6, lines 39-48). Therefore, it would have been obvious to one of ordinary skill in the art

at the time the invention was made to incorporate the use of Lipsit's service provider choosing into Fujiwara's system as this would allow the user to use the pre-registered mobile unit with any service provider upon initial connection and not be limited to any one specific service provider as Lipsit teaches the customer calling the provider of their choice.

As per Claim 48, the method of claim 46 wherein the requested registration information further comprises indicia of a requested type of service (user entering information) (at least col. 7, lines 3-53).

As per Claim 49, the method of claim 46 wherein the requested registration information further comprises a preferred user name (user entering information) (at least col. 7, lines 3-53).

As per Claim 50, the method of claim 46 wherein the reply message further comprises at least one protocol filter to restrict an access to the wireless network by the user equipment (at least col. 4, lines 15-34; restricting access).

As per Claims 51-53. Fujiwara and Lipsit fail to teach the reply message further comprising passing, from the registration server arrangement to the computer, a designation for an Internet service provider that the user equipment may access via the wireless network, registration web page information, and registration software program for execution by the user equipment. However, the use and advantages for using such registration information is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rai. Rai teaches wireless service providers providing internet access to end users (at least col. 5, lines 46-55; col. 8, lines 10-30;

col. 43, lines 5-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of Rai's registration methods into Fujiwara and Lipsit's system as this would further enhance Fujiwara and Lipsit's system by allowing the registration process to occur using the internet as selected by the user in Rai, to offer more functionality and ease of use in setting up such registration of the computer and as these are well known variations in the art for registering subscribers.

As per Claim 56, Fujiwara teaches a method for a user equipment (UE) for registering with a registration server of a wireless network for accessing the Internet through a UMTS access network, comprising:

the UE transmitting a temporary ID and a temporary password identifying the UE as unregistered, for authentication by an authentication server (temporary telephone number and ID) (at least col. 3 line 60 - col. 4 line 5; Fig. 3; col. 4, lines 15-35);

receiving, via the anonymous communication between the UE and the registration server via a radio access network and a core network, a reply message comprising a request for registration information, the registration information comprising a permanent ID and a permanent password, wherein the anonymous communication session is established with the radio access network and the core network (at least col. 7 line 54 - col. 8 line 16; permanent; col. 4, lines 15-35; radio link 24: radio access network, network 29/31: core network); and

transmitting, from the UE, the requested registration via the anonymous communication session with the registration server (at least col. 7 line 54 - col. 8 line 16; Fig. 15).

Fujiwara fails to explicitly teach receiving, at the UE, in response to the request for registration information, a permanent ID and a permanent password. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Lipsit. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Lipsit's system into Fujiwara as Lipsit's alternative activation/registration process allows the end recipient to activate the device using the ESN and security code of their choice.

Fujiwara and Lipsit fail to explicitly teach wherein the anonymous communication session is established using a tunneling communications protocol. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Rai. Rai teaches, in an analogous art, using Layer 2 tunneling protocol to connect user equipments and the interworking function in the networks for a secure connection (at least Rai col. 7:60-8:20). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Rai's layer 2 tunneling protocol

into Fujiwara and Lipsit's system as Rai teaches the use of such protocol being well known to allow support for ISP access and connecting to private networks, thus improving on Fujiwara and Lipsit's system to connect to such networks.

As per Claim 73. The computer readable medium of claim 69, wherein the anonymous communication session is a Layer 2 protocol link (at least Rai col. 7:60-8:20; Layer 2 tunneling protocol).

Claims 57-63, 66-67, 69, and 74 do not, in substance, substantially add or define any additional limitations over claims 46-53, 56, and 73 and therefore are rejected for similar reasons.

8. Claims 68 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Lipsit and Rai, and further in view of Bertrand et al (hereinafter "Bertrand", 6,687,252).

Fujiwara, Lipsit, and Rai fail to teach the INC further comprising a Serving GPRS Support Node (SGSN) and a RADIUS client. However, the use and advantages for using such a system is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Bertrand. Bertrand teaches a mobile terminal accessing a SGSN and Radius client (at least col. 10:48-51; 4:56-64). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the use of Bertrand with Fujiwara, Lipsit, and Rai's system because the technique for improving a particular class of devices was part of the

ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

Response to Arguments

9. Applicant's arguments filed 28 October 2010 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation the UE accessing the Internet through a UMTS access network, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For example, Applicant argues Fujiwara does not disclose receiving, from the UE, in response to the request for registration information, a permanent ID and a permanent password. However, Lipsit is relied on for having taught such. Similarly, Fujiwara and Lipsit are agreed to not explicitly disclose wherein the anonymous

communication session uses a tunneling communications protocol, as Rai is relied on for having taught such.

Further, Applicant argues Fujiwara does not disclose the registration server and authentication server. However, Fujiwara clearly teaches it being well known to authenticate the mobile unit to the communication network for connection (at least col. 1:30-35), and it would be inherent that such authentication would be done using a server. Similarly, Fujiwara teaches the entire detailed description (see exemplary col. 4:35-55) registering the mobile unit with the mobile communication network, and that such registering would inherently include a server.

Applicant further argues Fujiwara does not teach establishing an anonymous session. However, Fujiwara clearly teaches a temporary connection between a mobile unit and a mobile communication network (at least col. 4:15-35), wherein the temporary unit has restricted communication data.

Applicant further argues Fujiwara and Lipsit do not teach receiving, from the UE, in response to the request for registration information, a permanent ID and a permanent password. Lipsit teaches a recipient using a wireless device being prompted and requested to input a security code as well as an ESN to be sent to the MSC for the wireless device to be activated/registered (at least col. 9, lines 13-54). Further, Fujiwara additionally teaches the mobile device having a stored temporary or permanent ID (col. 7:54-8:16), and that ID is transmitted to the mobile communication network *from* the mobile unit in order to identify and authenticate the mobile unit when communicating with the network.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Xu et al, Himsworth and Lim, in addition to previously cited Short et al, Chuah, Holmes, Mosher et al, Hawkins, Grube et al, Dailey, Vilander et al, Larkins, Tiedemann, Freitag et al, Chatterjee et al, Jones et al, and Ronneke, are each cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art references for relevant teachings when responding to this office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2457

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Gregory G Todd/
Examiner, Art Unit 2457